

Albrecht, B.

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**REMARKS**

Claims 1-42 are pending in the present application. In the final Office Action mailed June 8, 2005, the Examiner rejected claims 1-11, 14-15, 22-26, and 32-46 under 35 U.S.C. §103(a) as being unpatentable over Kikuchi et al. (USP 5,250,786), taken with Japanese document no. JP4-356372A. The Examiner next rejected claims 3-8, 11-13, 16-21, 24-31, and 38-40 under 35 U.S.C. §103(a) as being unpatentable over Kikuchi et al. taken with the Japanese document no. JP4-356372A, and further in view of Paul et al. (USP 5,198,698).

**Finality of Action:**

In the Office Action of March 10, 2005, the first action in the above captioned matter, the Examiner rejected each of the claims of the present application under 35 U.S.C. §103(a) as unpatentable over several combinations of references. Each rejection included Japanese document no. JP4-356372A. MPEP §706.02.II requires that "[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." (Emphasis added). The Office Action did not include a translation of the document relied on. Accordingly, not knowing what the reference states about the Figures, Applicant was unable to fully respond to the Examiner's assertions as to what was shown in Figures of Japanese document no. JP4-356372A. Without a translation of the document, rejections relying on anything more than the translated abstract thereof are clearly improper. Applicant must be given an opportunity to respond. The converse is equally true – if Applicant submits a foreign language reference for consideration, the Applicant has the burden of supplying a translation for full consideration. If the Examiner uses a foreign language document, the Examiner must supply a translation as well.

As stated in MPEP §706.07, "Before a final action is in order, a clear issue should be developed between the examiner and applicant." MPEP §2271 further states that "[t]o bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final." MPEP §706.07 further states that "present practice does not sanction hasty and ill-considered final rejections" and "[t]he applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." MPEP §706.02.II requires a translation of a foreign

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language document that is relied upon by the examiner in a non-final action to allow an applicant an opportunity to respond. By relying on more than the abstract of JP4-356372A and not providing a translation therewith, Applicant has not been afforded a fair opportunity to address that which is disclosed in JP4-356372A. The finality of the currently pending Office Action is premature. Accordingly, Applicant requests that the finality of the June 8, 2005 be withdrawn as improper and further, that any subsequent action be non-final to afford Applicant an opportunity to develop a clear issue with the Examiner with respect to the claims as included herein.

**Rejection of claims:**

The Examiner rejected claims 1-11, 14, 15, 22-26, and 32-42 under 35 U.S.C. §103(a) as being unpatentable over Kikuchi et al. in view of JP4-356372A. The Examiner further rejected claims 3-8, 11-13, 16-21, 24-31, and 38-40 under 35 U.S.C. §103(a) as unpatentable over the combination of Kikuchi et al., JP4-356372A, and Paul et al. As argued above, to support these rejections, the Examiner is required to provide a translation of JP4-356372A in accordance with MPEP §706.02.II. Applicant appreciates the inclusion of the translation of this document in the Office Action of June 8, 2005. Having been provided an opportunity to review the entirety of the references applied in rejecting the present claims, Applicant has cancelled claims 1-15, amended selected claims in claims 16-42, and presented new claims 43-50 to clarify the present invention. Applicant appreciates entry and consideration of the claims as presented herein. Prior to addressing the patentability of the claims as presented herein, Applicant will address that which is disclosed in the art of record.

JP4-356372A discloses a soundproof welding device wherein a battery powered welder and an engine driven welder are enclosed in a soundproof enclosure. That is, JP4-356372A states that "... the built in engine welding machine and the battery welding machine [are capable of] being used independently or in combination." Pg. 3, lns 1-2. That is, the battery welding machine and the engine welding machine are each configured to independently generate a welding power. JP4-356372A further states that "[t]he output ends of the engine welding machine [55] and the battery welding machine [56] are connected in parallel" and that "[t]he reference numeral [33] in this case indicates an independent switch that is used for both of the above engine welding machine [55] and the battery welding machine [56]." Pg. 12, ln. 23 to pg. 13, ln. 3. That is, an operator, desiring more output than the engine welding machine can provide, manually selects to combine the output of the battery welding machine and the engine welding machine. Combination of the battery welding machine output and the engine welding machine output is determined by an operator requiring more weld power than the engine welding

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machine is capable of generating and requires manual configuration of the combined welding machines for such an output.

Kikuchi et al., similar to JP4-356372A, discloses an engine driven welder connected to a battery powered welding device. Kikuchi et al. states that "[t]he battery-driven welder 10 and the engine-driven welder 20 are separate d-c arc welders, which are changed over by a changeover switch 30 to select between high-power and low-power modes." Col. 4, lns. 55-58. Kikuchi et al. further states that "[t]he low-power mode is obtained, in which the battery-driven welder 10 and the engine-driven welder 20 can be operated individually" and that "[i]n Fig. 2, numeral 20 refers to an engine driven welder, and 10 to a battery-driven welder; both being provided individually." Col. 4, ln. 65 to col. 5, ln. 8. That is, Kikuchi et al. discloses a welding device wherein a battery-driven welder and an engine-driven welder are individually constructed to generate a desired welding power.

Marginally related thereto, Paul et al. discloses an auxiliary power supply system for providing DC power on demand. Paul et al. discloses an un-interruptible power supply (UPS) that is powered by a battery until it is determined that the power supplied by the battery is insufficient to provide the required power. Paul et al. states that "[u]pon determination that auxiliary power will be needed to augment the power supplied to the UPS, the engine of the auxiliary power system is started." Col. 3, lns. 31-34. Paul et al. further states that "... if the voltage across the DC bus lines drops below a predetermined value, indicating that either that the power outage is of a long duration or that the load on the battery through the UPS is sufficiently great that the battery is being rapidly drained, the system controller starts the engine of the auxiliary power system." Col. 4, lns. 54-60. That is, the battery provides a desired power until it is determined that the battery can no longer support the desired load at which point the engine driven power system supports the load.

Claim 16 has been amended to clarify that which is called for therein. Claim 16, calls for a method of generating a weld power from alternate power supplies which includes generating a weld power from an input supplied by an energy storage device, starting a fossil fuel driven engine upon generation of the weld power, and upon completion of starting the starting the fossil fuel driven engine, automatically transferring the supplied input power from the energy storage device to a power delivered from the fossil fuel driven engine without interruption of the weld power. That is, a weld power is generated from a power delivered from the energy storage device and the same weld power is maintained without interruption from a power delivered from a fossil fuel driven engine. The art of record fails to teach, suggest, or disclose such generation of a weld

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power. That is, both JP4-356372A and Kikuchi et al. disclose systems wherein weld power is generated independently from a battery power welding device and/or an engine driven welding device or through combination of the weld power outputs of both independent welding machines. Claim 16 calls for a weld power to be generated by the energy storage device and then automatically transferring the supplied input power to a power delivered from the fossil fuel driven engine. Such a method of generating a weld power is not taught or suggested in the art of record. Accordingly, Applicant believes that which is called for therein is patentably distinct over the art of record.

Claim 22 calls for a welding-type apparatus having a converter connected to an engine driven generator and an energy storage device also connected to the converter and configured to generate the welding-type power until the output of the engine driven generator is sufficient to provide the welding-type power. Both Kikuchi et al. and JP4-356372A disclose combined welding-type devices wherein the engine driven welder and the battery driven welder are independently operable. Such disclosure requires each of the engine driven welder and the battery driven welder to include independent converters to generate the desired welding-type power. That is, the same converter is not connected to both the engine driven generator and the energy storage device as called for in claim 22. Accordingly, Applicant believes that which is called for in claim 22 is patentably distinct thereover.

Claim 36 calls for, in part, a generator operatively connected to an internal combustion engine and configured to deliver a desired welding-type power and an energy storage device rechargeably connected to the generator and configured to deliver the desired welding-type power until an output of the generator is sufficient to deliver the desired welding-type power. That is, a single welding-type power, the desired welding-type power, is delivered alternatively from an engine driven generator and an energy storage device. Both Kikuchi et al. and JP4-356372A disclose systems wherein an engine driven welder and a battery driven welder operate individually to deliver a desired welding-type power or in combination to provide a desired welding-type power that is greater than either device can produce individually. The uninterruptible power system of Paul et al. discloses a system wherein the desired output is delivered from the battery power system until the power level of the battery system is insufficient to generate the desired output at which time the engine system is started and acquires the desired load. Unlike Paul et al., claim 36 calls for the energy storage system to deliver the desired load until the output of the generator is sufficient to deliver the desired power. Accordingly, Applicant

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believes that which is called for in claim 36, and the claims that depend therefrom, is patentably distinct over the art of record.

New claims 43-53 are also presented herein. Claim 43 calls for a dual powered welding-type device having a power supply constructed to receive a power signal and configured to generate a desired weld power from the power signal. Claim 43 further calls for an engine connected to a generator which is connected to the power supply and constructed to provide the power signal and a battery connected to the power supply and constructed to provide the power signal. That is, the power supply receives an input power signal from both the generator and the battery. Claim 43 includes a controller connected to the power supply and constructed to switch a source of the power signal between the generator and the battery based on an operating condition of the engine. That is, the desired weld power is generated by the power supply alternately from the power signal delivered from the generator and the battery as determined by an operating condition of the engine connected to the generator. As argued above, such a welding-type device is not taught, shown, disclosed, or suggested in the art of record. Kikuchi et al. and JP4-356372A disclose an engine powered welding device combined with a battery powered welding device. Each reference further disclosed that each of the engine powered welding device and the battery powered welding device are independently operable or cooperatively operable to attain a greater weld power than any of the welding devices can achieve individually. The power signal used to generate the desired weld power is determined by the individual output of any one of the individual devices. When the output of either of the individual sources is insufficient to generate the desired weld power, the weld outputs of the individual welders is combined. That is, the sources are connected and not switched between the sources based on an operating condition of the engine as called for in claim 43. As such, at least for the reasons set forth above, Applicant believes that which is called for in claim 43, and the claims that depend therefrom, is patentable distinct over the art of record.

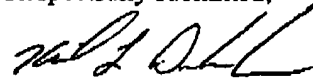
Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 16-50.

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Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



Kirk L. Deheck  
Registration No. 55,782  
Direct Dial 262-376-5170 ext. 16  
[kld@zpspatents.com](mailto:kld@zpspatents.com)

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**P.O. ADDRESS:**  
Ziolkowski Patent Solutions Group, SC  
14135 North Cedarburg Road  
Mequon, WI 53097-1416  
262-376-5170